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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/851,553	05/08/2001	Jerry Shaw-Yau Chang	PA1640US	4034
22830 7590 02/27/2007 CARR & FERRELL LLP 2200 GENG ROAD PALO ALTO, CA 94303			EXAMINER APPLE, KIRSTEN SACHWITZ	
			ART UNIT	PAPER NUMBER
			3693	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		02/27/2007	PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

# Office Action Summary

Application No.

09/851,553

Applicant(s)

CHANG ET AL.

Examiner

Kirsten S. Apple

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 22 November 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

***Drawings***

In view of the applicants arguments the drawing rejections is hereby withdrawn.

***Claim Rejections - 35 USC § 102***

The Examiner has read and reviewed all of the information provided by the Applicant.

The examiner rejects as final claims 1-8 & 10-11 under 35 USC 102.

The Applicant attention is re-drawn to the following:

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-7 & 10-14 & 16-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Hultgren US Patent 6,868,391 B1.

**Re claim 1:** Hultgren discloses:

*A method for settling an electronic transaction {see Hultgren "payment method"},  
comprising the steps of:  
a customer providing a merchant with a customer identifier {see Hultgren, Figure 3A, item 300},  
the merchant sending the customer identifier and a transaction amount to a settlement house {see Hultgren, Figure 2, item 206},*

*the settlement house contacting the customer {see Hultgren, Figure 3B, item 328},*  
*the customer selecting a payment method and transmitting the selected payment method*  
*to the settlement house {see Hultgren, Figure 3B, item 306},*  
*the settlement house sending the transaction amount and customer identifier to a*  
*financial service provider associated with the payment method {see Hultgren, Figure 3B, item 342*  
*& Figure 3C, Item 344},*  
*if the electronic transaction is approved by the financial service provider, {see Hultgren, Figure*  
*3A, Item 316},*  
*sending an approval to the settlement house {see Hultgren, Figure 3A, item 320};*  
*the settlement house sending the approval to the customer {see Hultgren, Figure 3B, item*  
*326};*  
*the customer approving the transaction amount {see Hultgren, Figure 3B, item 330}; and*  
*the settlement house finalizing the electronic transaction with the financial service*  
*provider and the merchant {see Hultgren, Figure 3C, item 344 & 346}*

**Re claim 2:** Hultgren discloses:

*Settlement house finalized the electronic transaction with a merchant's financial service*  
*provider {see Hultgren, Figure 3C, item 348}*

**Re claim 3:** Hultgren discloses:

*Financial service provider is a bank where customer has account {see Hultgren, Column 4,*  
*line 23-24}*

**Re claim 4:** Hultgren discloses:

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*Financial service provider is a credit provider where customer has account {see Hultgren, Column 4, line 24-25}*

**Re claim 5:** Hultgren discloses:

*Customer identifier is account number {see Hultgren, Column 5, line 59-62 & Column 14, line 15}*

**Re claim 6:** Hultgren discloses:

*Customer identifier is customer name {see Hultgren, Column 14, line 15}*

**Re claim 7:** Hultgren discloses:

*Customer uses mobile communication {see Hultgren, Figure 1, item 60}*

**Re claim 8:** Hultgren discloses:

*Mobile communication is Mobile telephone {see Hultgren, Figure 1, item 60}*

**Re claim 10:** Hultgren discloses:

*Payment method is credit card {see Hultgren, Column 1, line 22}*

**Re claim 11:** Hultgren discloses:

*Payment method is debit card {see Hultgren, Column 1, line 22}*

### ***Claim Rejections - 35 USC § 103***

The Examiner has read and reviewed all of the information provided by the Applicant.

The examiner rejects as final claim 9 under 35 USC 103.

The Applicant attention is re-drawn to the following:

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art

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to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 9 & 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hultgren US Patent 6,868,391 B1 in view of official notice.

**Re claim 9:**

*Mobile communication is handheld computing device*

*{The examiner argues official notice that one of ordinary skill in art at the time of the invention would substitute a handheld computing device such as a PDA to be used in place of a mobile phone. Many mobile phones at the time of the invention had both capabilities}*

Although Hultgren does not specifically have a handheld computing device, official notice clearly explains that it would be obvious to substitute a PDA for a mobile phone.

It is clear that one would be motivated to give multiple options and easy the process for the user.

**Re claim 12:** Hultgren discloses:

*If the electronic transaction is not approved by the financial service provider, the customer selecting an alternative payment method {The examiner argues official notice that one of ordinary skill in art at the time of the invention would know if one payment method does not work the customer has the option to pay by another payment method. Many times if the credit card transaction does not work they can pay by cash or check or another credit or debit card.}*

Although Hultgren does not specifically have another payment method, official notice clearly explains that it would be obvious to add this limitation.

It is clear that one would be motivated to give multiple options and easy the process for the user.

***Response to Arguments***

Applicant's arguments filed 8/18/06 & 11/22/06 have been fully considered but they are not persuasive.

In particular, and respect to Claim 1 the Applicant argued 1<sup>st</sup>: "Hultgren does not teach the customer identifier is transmitted to the merchant or the a settlement house."

The Examiner refutes the argument made by the Applicant and draws the attention to Hultgren, Figure 3A, item 300. Clearly a customer ID is provided this ID is used to confirm the customer which can be done at any location and have the same function. Additionally the examiner would like to argue that some customer ID must be sent along to the merchant and ultimately the settlement house otherwise the transition could not be complete. There are many ID that could work and this is simply a matter of design choice, a PIN number, a fingerprint, a account number, a coded account number, I could go on and on with well know ID in the art – all of which read on the current claim.

Applicants argued 2<sup>nd</sup>, "customer selects a payment method and transmitting the selected payment method to the settlement house."

The Examiner refutes the argument made by the Applicant and draws the attention to Hultgren, Figure 3B, item 306. Clearly the customer selects the payment and this information must be submitted to the payment house otherwise the transaction could not happen. There also can be a default selection which is a selection in itself.

Applicants argued 3<sup>rd</sup>, "customer ID is customer name"

The Examiner refutes the argument made by the Applicant and draws the attention to Hultgren, Column 14, line 15. While the examiner argues this is specifically referenced in the prior art as noted above the ID which is used is simply matter of design choice and there are many well know ID used in the art at the time of the invention including customer name.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

***Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kirsten S. Apple whose telephone number is 571.272.5588. The examiner can normally be reached on Monday - Friday 9:00-5:30.

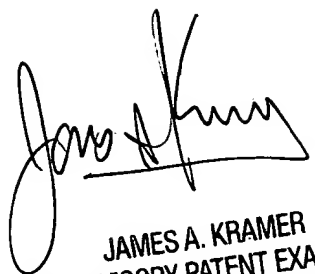
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Kramer can be reached on 571-272-6783. The fax phone number for the organization where this application or proceeding is assigned is 571-272-6126.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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ksa

A handwritten signature in black ink, appearing to read "James A. Kramer", with a large loop at the end of the last name.

2/15/07

JAMES A. KRAMER  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600